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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,650	10/15/2001	Per Sjoberg	0459/00346	5908

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EXAMINER

MILLER, EDWARD A

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 10/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/869,650

Applicant(s)

SJOBERG, PER

Examiner

Edward A. Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-7 and 9-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-13 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7. 6) ☐ Other: ____

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1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-2, drawn to a method of making a device.

Group II, claim(s) 4-7 and 9-13, drawn to compositions.

Group III, claim(s) 3 and 8, drawn to a method of reprocessing.

2. The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Groups I and III are independent. Groups I and III could be regarded as separate methods of using the Group II composition. On reconsideration, Groups I and II will both be examined. Applicant is entitled to a composition and a method of use, but not two separate methods of use. There is no proper special technical feature common to the separate groups of invention, see the action as to prior art below. Note MPEP 1850 regarding the relevant PCT rule, reproduced in pertinent part, emphasis added:

PCT Rule 13.2, as it was modified effective July 1, 1992. ... Unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more special technical features. The term "special technical features" is defined as meaning those technical features that **define a contribution which each of the inventions considered as a whole, makes over the prior art**.

3. During telephone conversations with Mr. Amernick, on October 9 and 17, 2002, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-2. Affirmation of this election must be made by applicant in replying to this Office action. Group III,

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claims 3 and 8 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Groups I and II will be examined together.

4. Applicant cannot rely on foreign priority papers to overcome any prior art rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. MPEP § 201.15.

5. New, corrected drawings are required in this application because the drawing as filed is informal and fails to comply with US drafting requirements. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-2, 4-7 and 9-13 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite since it is not clear what the claimed invention is. Partly, it appears that the claims intend to encompass a plurality of statutory groups of invention within a single claim. Claims 1-2 are indefinite because they apparently may include a plurality of different methods within a method claim. As best understood, claim 1 requires making a device by using a composition. There is no method step in this recitation that relates to any device limitations. Thus, the preamble is inconsistent with the body of the claim. Also, the closest language that includes a method limitation relates to the later, intended use of the device prepared, but an intended use is not part of

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the stated, claimed method. There are method limitations within a product claim. In, for example, claim 5, lines 3-5 require regulating the rate of burning by admixing. "Admixing" is clearly a method step within a composition claim. In claims 7, lines 2-3, and correspondingly in claims 12 and 13, the limitation of "used in the form of", is not a composition limitation, but appears to be an implied method, as best understood. These exemplary problems render the claims indefinite, as it cannot be determined what type of claim is being claimed, e.g., what the claimed invention is. As set forth in *Ex parte Lyell* (BdPatApp&Int) 17 USPQ2d 1548, "a claim which is intended to embrace both product or machine and process is precluded by language of 35 USC 101, which sets forth statutory classes of invention in alternative only, and is also invalid under 35 USC 112, second paragraph, since claim which purports to be both machine and process is ambiguous and therefore does not particularly point out and distinctly claim subject matter of invention."

Claim 4, as amended, recites a substance made according to the method of claim 1. However, claim 1 recites a method of making a device, e.g., a car safety device. This cannot be understood. Further, claim 4 recites "substances for ... car safety devices..." in line 1, but then in line 3, recites wherein "they contain [GDN]...." This is indefinite, since it is not clear if "they" refers to the "substances" or to the "devices". Thus, "they" lacks a clear, proper antecedent basis. Further, if the antecedent basis is to the device, this is again improper inclusion of plural statutory categories of invention within a single claim. This problem relates to all "composition" claims. Also in claim 4, "substance" is used in the plural in line 1, but in the singular in line 4 thereof, which is inconsistent and renders the claim indefinite, throughout. In claims noted above which include method limitations, it is not clear what is meant. For example, in claims 7, 12 and 13, the "used in the form of" might be an intended use, which intended use is not prohibited, but does not further serve to limit the composition of the claims from which these claims depend. Thus, these claims, if

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such is intended, fail to further limit the claims they depend from, and are thus improper and cannot be understood, as to the intended limitation. In claims 2 and 5, penultimate line of each, the term “required” is used, without any manner of, or parameters for, determining the “required” amount. Similar issues relate to a “suitable” amount.

Throughout, the recitation of “such as”, “etc.”, “possibly” and so on are indefinite. These render the claims indefinite because it is unclear whether the limitations following (referred to from, in the case of “etc.”) the phrase are part of the claimed invention. See, e.g., MPEP § 2173.05(d).

Claims 1-2 are incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are that the claims is a method of making a device, but there are no device limitations recited.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. The above are exemplary; the claims should be completely revised to be in accord with US practice.

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1-2 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966). See also *Ex parte Lyell* (BdPatApp&Int) 17 USPQ2d 1548, as set forth

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in paragraph 7, above. Claims 1-2 provide for the use of GDN, but, since the claims do not set forth any steps involved in the process, it is unclear what process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

10. Claims 1-2, 4-7 and 9-13 are rejected under 35 U.S.C. 101 because these claims apparently are intended to encompass a plurality of statutory classes of invention, that is, they are not drawn to “a method ... or See paragraph 7 above, the part thereof quoting *Ex parte Lyell* (BdPatApp&Int) 17 USPQ2d 1548, incorporated herein by reference.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b).

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Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

13. Claims 1-2, 4-7 and 9-13 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Blomquist, 6,004,410.

As best understood, Blomquist '410 anticipates these claims with the teaching of airbag devices with GDN (guanidine dinitramide), for example, at col. 2, line 32. In the instant claims, a "suitable" amount of guanyl urea dinitramide is 0% to obtain the examiner's required burning rate. Likewise, "possible" amounts of binder include 0%, and more than 50% of GDN includes 100%. Thus, as best understood, no claim requires any additional ingredient beyond GDN.

14. Claims 4-7 and 9-13 are rejected under 35 U.S.C. 102(b) as being anticipated by, or under 35 USC 103 as unpatentable over Bottaro et al. '204, Martin et al., and Pinkerton et al.

In Botarro et al. '204, see col. 4, line 65, which teaches guanidinium dinitramide, or at least clearly suggests, makes obvious, this compound. In the abstracts of the Martin et al and Pinkerton et al. articles, guanidinium dinitramide is taught, although other terminology is used. [Note the search terms and the structure found.] As best understood, these claims admit of additional ingredients, but do not require such. As to additional ingredients, see col. 13 above on the breadth of claim terms not requiring such. That good benefits are found for using the old substances is irrelevant. It is clear that a new intended use does not does not confer patentability on an otherwise old composition. See, for example, *In re Thuau*, 135 F.d 344, 1943 C.D. 390, *In re Pearson*, 181 USPQ 641, and *In re Touminen*, 213 USPQ 89.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Blomquist '255 and WO 98/55428 teach guanylurea dinitramide in air bag compositions and devices.

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16. Any inquiry concerning either this or an earlier communication from the Examiner should be directed to Examiner Edward A. Miller at (703) 306-4163. Examiner Miller may normally be reached Monday-Thursday, from 10 AM to 7 PM.

If attempts to reach Examiner Miller by telephone are unsuccessful, his supervisor Mr. Carone can be reached at (703) 306-4198. The Group fax number is (703) 305-7687.

If there is no answer, or for any inquiry of a general nature or relating to the application status, please call the Group receptionist at (703) 308-1113.

Miller/em
October 18, 2002



EDWARD A. MILLER
PRIMARY EXAMINER